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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,622	02/01/2000	Richard Leinfellner	019491-004510US	5097
58201                      7590                      08/05/2008 TOWNSEND AND TOWNSEND AND CREW LLP/EA TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER VAUGHN, GREGORY J				
ART UNIT 2178		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/495,622

**Applicant(s)**

LEINFELLNER ET AL.

**Examiner**

GREGORY J. VAUGHN

**Art Unit**

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Action Background***

1. This action is responsive to Request for Continued Examination filed 5/28/2008.
2. Applicant has amended claims 1, 9, and 19. Claim 8 was previously canceled.
3. Claims 1-7 and 9-21 are pending in the case. Claims 1, 9 and 19 are independent claims.
4. A request for continued examination filed under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 2/9/2004) has been withdrawn pursuant to 37 CFR 1.114.
5. The rejection of claims 1-4, 7-13, 19 and 21, rejected under 35 U.S.C. 102(a), as described in the office action dated 2/9/2004, is withdrawn in view of the amended claims, however new grounds of rejection are made, as described below.
6. The rejection of claims 5, 6, 16, 17 and 20, rejected under 35 U.S.C. 103(a), as described in the office action dated 2/9/2004, is withdrawn in view of the amended claims, however new grounds of rejection are made, as described below.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

8. Claims 1-4, 7, 9-13, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisk, US Patent 6,280,325, filed 5/13/1999, patented 8/28/2001, in view of the Help System of the SnagIt software (Version 4.3), by TechSmith Corporation, with an release date of November 14, 1998.
9. **Regarding independent claim 1**, Fisk is directed toward a computer based gaming system which incorporates messaging capabilities within the gaming system. Fisk recites: *"When supervisor 64 confirms that the entered number is the number drawn by ball machine 56, game computer 50 broadcasts a message indicating the called number to all computers in the network"* (column 13, lines 8-12). Fisk discloses several message types. Fisk recites: *"FIGS. 4A through 4N illustrate messages transferred between computers of the computer network illustrated in FIG. 3 as part of administering bingo games"* (column 7, lines 21-24).

Fisk's gaming system manages messaging, as described above. Fisk fails to disclose selecting an image from the game, and incorporating the image into the message. The SnagIt Help System discloses a method and computer readable

medium for sending a message from within an application (see figure 3, *Send Mail (Output)* topic, which describes messaging; figure 4, *Activation SnagIt/32 from Word for Windows* topic, which describes a typical application; figure 5, *Windows Application* topic, which describes other applications; and figure 6 *System Requirements*, which describes a typical computer readable medium wherein the SnagIt system would operate).

The SnagIt Help System discloses receiving a user input to select an image and audio, where image and audio together indicates multimedia (see figure 7, *Changing the Hotkey Combination* topic, which indicates the action the user would take to select an image; and see figure 8 *Audio Format (output Properties)* topic, which describes audio capture information). The SnagIt Help System discloses generating a message form and adding message information, where the image and the message information are combined (see figure 3, *Send Mail (Output)* topic, which describes the message form as *32-bit MAPI client* and a capability to add an *optional short message*). The SnagIt Help System discloses sending the composite message (see figure 9 *Sending the Capture to Someone using E-Mail* topic, which discloses the destinations supported for message transmission).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to use the image capture feature of SnagIt with the electronic game messaging system of Fisk in order to provide a system that accommodates many users simultaneously.

10. **Regarding dependent claims 2, 3, 4 and 7**, the SnagIt Help System discloses the message information to include recipient address information and message text (see figure 10, *Output Properties* dialog box, *Prompt each time* setting), a container to receive the recipient address that is attached to the message for transmission (see figure 10, *Output Properties* dialog box, *Prompt each time* setting), and a method to send the message to a predetermined recipient (see figure 10, *Output Properties* dialog box, *Don't Prompt, Use preset* setting).
11. **Regarding Independent claims 9 and 19**, the claims are directed toward a method and computer readable medium for the method of claim 1, and are rejected using the same rationale.
12. **Regarding dependent claims 10 and 11**, the SnagIt Help System discloses images combined with audio as a movie (compare Multimedia to movie) (see figure 11, *Video Capture Overview* topic, which discloses *moving images* (paragraph 1, line 1) and *adding audio* (paragraph 2, bullet 2)).
13. **Regarding dependent claims 12, 13 and 21**, the SnagIt Help System discloses the capability to crop images (compare removing extraneous information to crop) (see figure 12, *Crop – Catalog Viewer Edit Menu* topic); and to scale images to a smaller size (see figure 13, *Scale - Catalog Viewer Image Menu* topic, which discloses both scaling down and scaling up).

14. Dependent claims 5, 6, 16, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisk and the SnagIt Help System in view of Snook, US Patent 6400378 (filed 9/26/1997).
15. **Regarding dependent claims 5, 6, 16, 17 and 20**, Fisk and the SnagIt Help System fail to disclose the functionality related to pause and resume of the application. Snook discloses the pausing and resumption of the current application (described as scanning) *"The dialog box has a function pause, resume and stop. When the pause button is selected, the scanning process is paused temporarily. The user needs to press the resume button to continue the scanning process"* (column 4, lines 26-30).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Fisk and the SnagIt System to include the pause and resume functionality disclosed by Snook. One of ordinary skill in the art would have been motivated to add pause and resume to Fisk and the SnagIt system to allow the system user to return to the application at the precise moment the application was interrupted, and to continue to use the application without the loss of interaction with the application.

16. Dependent claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisk and the SnagIt Help System in view of Killcommons et al., US Patent 6424996 (filed 11/25/1998).
17. **Regarding dependent claim 14**, Fisk and the SnagIt Help System fail to disclose the compression of multimedia files. Killcommons discloses *"the server will include a*

*processing unit, which may be coupled to the assembly unit or the data interface, configured to encode, compress and/or encrypt the medical data (e.g., prior to the data being assembled into an e-mail package"* (column 4, lines 5-9).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Fisk and the SnagIt System to include the compression of multimedia files. One of ordinary skill in the art would have been motivated to add multimedia file compression to Fisk and the SnagIt system to permit fast transfers of compressed files to intended recipients.

18. **Regarding dependent claim 15**, the SnagIt Help System discloses a message supported by the *32-bit MAPI mail client* (compare *electronic mail protocol* with *32-bit MAPI mail client*) (see figure 3).
19. Dependent claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisk and the SnagIt Help System in view of Toyoda, US Patent 6094277 (filed 11/3/1998).
20. **Regarding dependent claim 18**, Fisk and the SnagIt Help System fail to disclose a confirmation to the sender that the message has been received. Toyoda discloses "*E-mail communication method for the Internet facsimile comprising the steps of receiving E-mail from a network, creating identification data from the received mail, creating reply mail including said identification data, and notifying said reply mail to the sender of said received mail*" (column 2 lines 12-17).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Fisk and the SnagIt System to include



confirmation notification of the sent message. One of ordinary skill in the art would have been motivated to add confirmation notification so that the sender would be aware of the status of the sent message.

### ***Response to Arguments***

21. Applicant's arguments with respect to claims 1-7 and 9-21 have been considered but are moot in view of the new ground(s) of rejection, as described above.

### ***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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July 28, 2008